

REMARKS

Claims 23, 25-28, 55, and 56 are pending. Claims 31-42 and 45-54 have been canceled without prejudice to prosecution in related cases.

Rejections under 35 U.S.C. §112, first paragraph

Claims 55 and 56 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully disagree.

The written description requirement of §112, first paragraph, is met so long as the invention is described in the specification as broadly as it is claimed. The written description requirement ensures that, as of the filing date, the inventor conveyed with reasonable clarity to those of skill in the art that he was in possession of the subject matter of the claims. *Vas-Cath Inc. v. Mahurkar*, 19 U.S.P.Q.2d 1111, 1117 (Fed. Cir. 1991).

Although the Office Action alleges that there is no support for the identification step of claim 55, this step is set forth throughout the application as originally filed. See, for example, page 12, lines 16-22. In particular, Applicants point to the language “solutions of PNAs can be used to disinfect objects that have been contaminated with a particular bacteria” (page 12, lines 17 and 18). Such language clearly shows selection of a bacteria to be killed or inhibited, and the use of a PNA to perform this task. To target a “particular bacteria”, one must have selected that bacteria as the target. As such, the specification does enable the step of selecting a bacteria. The Office Action also alleges that the timing of the bacterial selection is vague. (July 1, 2002 Office Action at page 3). Claim 55 has been amended to clarify that a bacteria is selected and then killed or inhibited. Applicants believe that the claim satisfies §112, first paragraph, and that the rejection should be withdrawn.

Claim 56 has been rejected under 35 U.S.C. § 112, first paragraph, as the specification allegedly does not show that the Applicants had possession of the generic method of examining the killing of bacteria or inhibition of bacterial growth. Applicants

respectfully traverse this rejection. The Office Action acknowledges that one skilled in the art “would be able to employ routine laboratory experimentation to examine PNA effects on target bacteria.” (July 1, 2002 Office Action at page 3). Consistent with this, the first paragraph of § 112 requires that the disclosure of a patent application be such that persons skilled in the art, having read the patent application, would be able to practice the inventions described by the claims. *In re Wands*, 8 U.S.P.Q.2d 1400 (Fed. Cir. 1988). There is no legal requirement that this be done in any particular manner. An enabling disclosure can be provided by the use of illustrative examples or simply by broad terminology. *In re Marzocchi*, 169 U.S.P.Q. 367 (C.C.P.A. 1971). In the instant application, the enabling disclosure is by illustrative examples. Applicants note that one of skill in the art, having read the present application, would readily be able to examine the killing or inhibiting of the growth of bacteria subsequent to contacting the bacteria with PNAs. This is supported by the Office Actions’s above-noted statement regarding the level of skill in the art. For example, Example 7, (page 22) describes treating *E. coli* with PNAs and growing the bacteria on agar media to determine if the bacteria are killed or inhibited. One skilled in the art, having read the present application, in particular page 22, line 17-35, would readily appreciate that the inventors had possession of the claimed method of killing or inhibiting growth of bacteria comprising contacting said bacteria with a peptide nucleic acid where the killing of the bacteria or the inhibiting of the bacteria’s growth is examined after contacting the bacteria with the PNA. In Example I(4), for example, the specification describes the use of visual inspection for the presence of growth on an assay. Procedure 1 on pages 35-40 describes assay methods of determining bacteria activity. These procedures use visual inspection and UV absorbance detection techniques. This disclosure demonstrates that the applicants were in possession the claim inventions, and that the written description enables one skilled in the art to examine killing or inhibiting of the growth of bacteria subsequent to contacting the bacteria with PNAs. As such, Applicants respectfully request that the rejection under § 112 be reconsidered and withdrawn.

Obviousness-type Double Patenting

Claims 23 and 25-28 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-6 and 12 of U.S. Patent 6,300,318. Applicants respectfully disagree. However, in order to advance the prosecution of this application, when claims are allowed in the present application, Applicants will file a terminal disclaimer over U.S. Patent 6,300,318.

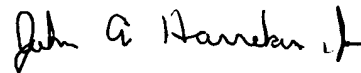
Non-Elected Claims

The cancellation of claims 31-42 and 45-54 is believed to satisfy the Office Actions requirements in this matter.

Attached hereto is a marked-up version of the changes made to the application by the current amendment. The attached page is captioned **“Version with markings to show changes made.”**

The foregoing represents a *bona fide* attempt to advance the present application to allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

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the Claims

Please cancel claims 31-42 and 45-54 without prejudice.

Please amend claim 55 as follows.

55. (Amended) A method of killing or inhibiting growth of bacteria comprising:

- (a) [the step of identifying] selecting a bacteria to be killed or inhibited; and
- (b) contacting said bacteria to be killed or inhibited with a peptide nucleic acid.